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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/813,153	03/30/2004	Jean-Pierre Leblanc	SPG6601US1	5423

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EXAMINER

VENKAT, JYOTHSNA A

ART UNIT	PAPER NUMBER
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1619

NOTIFICATION DATE	DELIVERY MODE
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08/19/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/813,153	Applicant(s) LEBLANC ET AL.	
	Examiner JYOTHSNA A. VENKAT	Art Unit 1619	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17 and 23-28 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 17 and 23-28 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/2/09 has been entered.

Status of claims

Claims 1-17, 18-22 and 29-30 are **cancelled**. Claims 17 and 23-28 are pending in the application.

Claim Rejections - 35 USC § 112

Claims 17 and 23-28 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

There is lack of written description for claim 17. See below for claim 17.

claim17. (Currently amended) A method of treating skin comprising applying to the area of skin to be treated a skin care composition comprising a neutralized, solubilized anionic polyurethane, a second solubilized polymer selected from the group consisting of acrylate, polyacrylate, methacrylate and polymethacrylate polymers, and at least one solvent, and from about 61 wt.% to about 76 wt% by weight of the composition of water, wherein the skin care

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composition is selected from the group consisting of sunscreens, suntan compositions, after-sun compositions, hand moisturizers, body moisturizers, face creams, face lotions, skin tightening compositions, skin firming compositions, skin cleansing compositions, color cosmetics, and whitening compositions.

Applicants' point out support for the range of water which is "about 61%" to example 5 "about 76%" to example 6.

The support in examples 5 and 6 is for "sunscreen emulsions" and the second polymer being "polyacrylate".

There is no support in examples 5 and 6 for polymethacrylate as the second solubilized polymer using the specific amount of water claimed in claim 17. Specification does not describe amount of water other than amount disclosed in the examples. There is lack of written description for skin care composition having the specific amount of water using any composition of claim 17 other than "sunscreen" since examples 5-6 are drawn to "sun screen". The support in the examples 5 and 6 is 7.28 and 4 % using specific mixture of polyurethane and polyacrylate using the specific amount of water. There is lack of written description for the amount claimed in claims 23-28 for polyurethane and polyacrylate. respectively.

Claim Rejections - 35 USC § 112

Claims 23-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Claims 23-28 lacks antecedent basis since claim 17 recites “ pre neutralized , solubilized anionic polyurethane “ and not “ polyurethane”. Claim 17 recites “second solubilized polymer” and not “ second polymer” .

The term "at least about" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, one of ordinary skill in the art would not be reasonably apprised of the scope of the invention, because one of skill will not be able to determine which term is in control. The claims lack clarity as to whether "at least" (a lower limit) or about "(broadening limitation, both higher and lower) it is unclear what controls the metes and bounds of the phrase "at least about". *Amgen, Inc. v. Chugai Pharmaceutical co., 18 USPQ 2D 1016.*

The term "greater than about" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention, because one of skill will not be able to determine which term is in control. The claims lack clarity as to whether "greater" (a lower limit) or about "(broadening limitation, both higher and lower) it is unclear what controls the metes and bounds of the phrase "greater than about".

Claim Rejections - 35 USC § 103

1. Claims 17 and 23-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of U. S. Patents 6,010,686 ('686) and 5,626,840 ('840) and 6,264,933 ('933) and 6,039, 935 ('935).

Instant application is claiming a method of treating skin comprising:

1. Neutralized, solubilized anionic polyurethane

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2. *Solvent*

3. *Second polymer. The specification defines "solubilized urethane" as urethane being soluble in solvent.*

4. *Water*

Patent '686 teaches cosmetic composition using a polymeric system, which contains one film-forming polymer and use of this composition on the skin. See the abstract, see col.1, ll 1-16.

Patent '686 at col.2, ll 10-26 teaches:

10 The composition according to the invention makes it possible to obtain a homogeneous film which has a light texture and remains comfortable to wear all day long. The film is not at all sticky, while being soft, supple, elastic and flexible on the skin; it follows the movements of the support
15 on which it is applied without cracking and/or lifting off. It adheres completely to the lips. The composition according to the invention therefore is particularly advantageous as a composition for application to the lips, especially as lip rouge. The composition according to the invention also is
20 particularly advantageous as a composition for application as an eyeliner.

25 Furthermore, the film obtained in accordance with the present invention can be very glossy or more or less matte, depending on the nature of the particular constituents of the composition. This results in a wider range of make-up products which can be made glossy or matte at will.

Patent at col.2, ll 35-40 teaches various polyurethanes and this includes anionic polyurethane. Patent at col.4, ll 10-24 teaches:

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- 10 In the present description "dispersion of film-forming polymer" is intended to mean a dispersion capable of forming a film, including or not including a coalescing agent.
- 15 The solids content of the aqueous dispersions according to the present invention may range from 5 to 60% by weight, and preferably range from 30 to 40% by weight.
- The composition of the invention may include from 1 to 60% by weight, preferably from 5 to 40% by weight, of dry solids of film-forming polymers.
- 20 The particle size of the polymers in aqueous dispersion may range from 10 to 500 nm and preferably ranges from 20 to 150 nm, which makes it possible to obtain a film which has a remarkable gloss.

Patent at col.4, ll 40-45 teaches plasticizing agent and this includes water soluble solvents and water insoluble solvents. Patent at col.4, ll 50-62 teaches various glycol derivatives. Patent at col.5, ll 22-30 suggests adding additives like acrylic polymer into the compositions. See examples and see claim 2 for anionic polyurethane. Patent does not teach neutralized polyurethane.

Patent '840 teaches claimed anionic solubilized neutralized polyurethanes. Patent '840 teaches anionic polyurethanes which can be soluble or dispersible in water. See the abstract, and see col.2, ll 16-19 for the weight percent. Patent at col.5, lines 52-63 teaches:

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Neutralization renders the polymers soluble or dispersible in water for easy formulation into aqueous hair sprays (and thus contributes to removability). The neutralized polymers can be formulated solely in water as the solvent, or the solvent system can be a blend of polar organic solvent and water. Typically, the organic solvent will be an alcohol or ketone. Particularly suitable solvents are low boiling alcohols that are compatible with other components in the hair fixative composition, for example, C₁-C₄ straight or branched chain alcohols. Exemplary polar solvents are ethanol, propanol, isopropanol, butanol, acetone, dimethyl-ether and dimethoxymethane.

The difference between these patents and the instant application is they do not teach second polymer and the amount of water, which is from about 61% to about 76 %.

However patent '933 teaches film forming polymer and this includes anionic polyurethane as the film forming polymer. See col.2, line 34 and see col.4, ll 5-8 for the weight percent of the polymer. Patent '933 teaches various solvents at col.4, ll 17-25. Patent at col.4, ll 30-50 teaches additional film forming polymer can be added into the compositions and this includes polyacrylates and polymethacrylates claimed in the instant application.

Patent '935 teaches sunscreen compositions. Sunscreen compositions are used for treating skin. Patent '935 teaches at col.2, line 45 amount of water. The amount of water claimed is within the weight percent taught by patent.

Accordingly it would be obvious to one of ordinary skill in the cosmetic art to prepare compositions of patent '686 and **substitute** the anionic film-forming polymer with another functionally equivalent film forming polymer, which is neutralized solubilized anionic polyurethane of patent '840 and add additional film forming polymer (polyacrylate or polymethacrylate) taught by patent '933 in analogous cosmetic compositions and add the amount of water taught by patent '935. One of ordinary skill in the cosmetic art would modify the

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compositions of patent '686 by using neutralized and solubilized anionic polyurethane since these anionic polyurethanes are soluble in water for easy formulations. This is a prima facie case of obviousness.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 17 and 23-28 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 4 and 6-12 of copending Application No. 11/116,638. Although the conflicting claims are not identical, they are not patentably distinct from each other because copending application is claiming the skin care composition and instant application is claiming method of treating skin using the same skin care compositions. It is obvious to use the skin care compositions for treating skin.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTHSNA A. VENKAT whose telephone number is 571-272-0607. The examiner can normally be reached on Monday-Friday, 10:30-7:30:1st Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MICHAEL WOODWARD can be reached on 571-272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JYOTHSNA A VENKAT /
Primary Examiner, Art Unit 1619